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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/422,803 10/22/99 SOUTHERN E 00263/FP/IR/

HM22/0227

EXAMINER

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WASHINGTON DC 20006

MARSCHEL, A

ART UNIT	PAPER NUMBER
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1631

DATE MAILED: 02/27/01 C

Please find below and/or attached an Office communication concerning this application or proceeding.

**Commissioner of Patents and Trademarks**

<b>Office Action Summary</b>	Application No. 09/422,803	Applicant(s) Southern
	Examiner Ardin Marschel	Group Art Unit 1631

Responsive to communication(s) filed on Dec 14, 2000

This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle* 1035 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

#### Disposition of Claim

- Claim(s) 17-40 is/are pending in the application.
- ~~Claim(s) 1-16 have been canceled.~~ ~~is/are withdrawn from consideration~~
- Claim(s) \_\_\_\_\_ is/are allowed.
- Claim(s) 17-40 is/are rejected.
- Claim(s) \_\_\_\_\_ is/are objected to.
- Claims \_\_\_\_\_ are subject to restriction or election requirement.

#### Application Papers

- See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.
- The specification is objected to by the Examiner.
- The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. § 119

- Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- All  Some\*  None of the CERTIFIED copies of the priority documents have been
- received.
  - received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
  - received in this national stage application from the International Bureau (PCT Rule 17.2(a)).
- \*Certified copies not received: \_\_\_\_\_
- Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

#### Attachment(s)

- Notice of References Cited, PTO-892
- Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- Interview Summary, PTO-413
- Notice of Draftsperson's Patent Drawing Review, PTO-948
- Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

Applicants' arguments, filed 12/14/00, have been fully considered but they are not deemed to be persuasive. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.

The submission of the substitute specification with abstract and oath is hereby acknowledged and approved and have been entered.

Claims 23 and 30 are rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Consideration of the instant disclosure as filed has failed to reveal the following newly submitted claim limitations and are therefore NEW MATTER:

claims 23 and 30:  $10^{12}$  locations; It is noted that

$1.1 \times 10^{12}$  locations on page 6, line 31, as filed, is not the same as  $10^{12}$  locations.

The non-statutory double patenting rejection, whether of the obviousness-type or non-obviousness-type, is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent. *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); *In re*

*Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); and *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(b) and (c) may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.78(d).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 17-40 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over either claims 1-8 of U.S. Patent No. 5,700,637 or claims 1-12 of U.S. Patent 6,054,270. Although the conflicting claims are not identical, they are not patentably distinct from each other because methods of making an array and analysing an array regarding hybridization are claimed in all three sets of claims with details therein varying in the claims but are disclosed in the various specifications as clear species for the performance of each set of claims. The array claims of the instant application are deemed obvious also over the method of making claims in the Patent 5,700,637 as the arrays made by those methods are clearly suggested via the preparatory claims. It is noted that an array claim is present in Patent 6,054,270.

Claims 17-32 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 17-26 of copending application Serial

No. 09/300,279. Although the conflicting claims are not identical, they are not patentably distinct from each other because methods of making an array and arrays made are deemed obvious over each other.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 33-40 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 17 of copending application Serial No. 09/498,029. Although the conflicting claims are not identical, they are not patentably distinct from each other because methods of labeled array hybridization analysis are deemed obvious variants as given in both sets of claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 32-40 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 17-28 of copending application Serial No. 09/619,645. Although the conflicting claims are not identical, they are not patentably distinct from each other because common embodiments of methods of analysing an array regarding hybridization are claimed in both sets of claims.

This is a *provisional obviousness-type double patenting* rejection because the conflicting claims have not in fact been patented.

Claims 17-40 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 17-87 and 89-99 of copending application Serial No. 09/422,804. Although the conflicting claims are not identical, they are not patentably distinct from each other because methods of making an array and analysing an array regarding hybridization are claimed in both sets of claims with details therein varying in the claims but are disclosed in the various specifications as clear species for the performance of each set of claims. The array claims of the instant application are deemed obvious also over the method of making claims.

This is a *provisional obviousness-type double patenting* rejection because the conflicting claims have not in fact been patented.

Claims 33-40 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 17-29 of copending application Serial No. 09/691,223. Although the conflicting claims are not identical, they are not patentably distinct from each other because methods analysing an array regarding hybridization are claimed in both sets of claims with details therein varying in

the claims but are disclosed in the various specifications as clear species for the performance of each set of claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

No claim is allowed.

Papers related to this application may be submitted to Technical Center 1600 by facsimile transmission. Papers should be faxed to Technical Center 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993) (See 37 CFR § 1.6(d)). The CM1 Fax Center number is either (703) 308-4242 or (703) 305-3014.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ardin Marschel, Ph.D., whose telephone number is (703) 308-3894. The examiner can normally be reached on Monday-Friday from 8 A.M. to 4 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward, Ph.D., can be reached on (703) 308-4028.

Any inquiry of a general nature or relating to the status of this application should be directed to Patent Analyst, Tina Plunkett, whose telephone number is (703) 305-3524 or to the Technical Center receptionist whose telephone number is (703) 308-0196.

February 23, 2001

*Ardin H. Marschel*  
ARDIN H. MARSCHEL  
PRIMARY EXAMINER